

REMARKS

I. Introduction

Claims 1, 5, 19 and 20 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 19 to 20 Under 35 U.S.C. § 112

Claims 19 to 20 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Office Action contends that “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Office Action at page 2. The Office Action states that “[t]here is no support in the specification for the claimed method of manufacturing a filter element for a dialyzer set forth in claims 19-20.” Office Action at page 2.

Applicants respectfully disagree and maintain that the recitation in claims 19 and 20 of manufacturing a filter element for a dialyzer is fully supported by the originally-filed Specification and drawings. For instance, the Specification states at page 1, lines 3 to 4, that “[t]he present invention relates to a method for the manufacture of fiber bundles and to an apparatus for manufacturing fiber bundles.” The Specification also states at page 1, lines 6 to 7, that “[i]n known methods for the manufacture of fiber bundles, for example for the manufacture of dialyzers ...” Emphasis added. In addition, the Specification states at page 1, lines 6 to 7, that the “structure [of the present invention] can substantially improve the performance rating of the fiber bundle, when used for example, in a dialysis machine.” Emphasis added. Fiber bundles are employed as the filter element of dialyzers. Therefore, the recitation in claims 19 and 20 of manufacturing a filter element for a dialyzer is fully supported by the originally-filed Specification and drawings.

In view of the foregoing, it is respectfully submitted that claims 19 and 20 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

III. Rejection of Claims 5 and 20 Under 35 U.S.C. § 102(b)

Claims 5 and 20 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 1,965,464 ("Koehler"). Applicants respectfully submit that Koehler does not anticipate claims 5 and 20 for the following reasons.

Claim 5 relates to a method for manufacturing fiber bundles having a fiber bundle length. Claim 5 recites that the method includes the step of transporting a fiber bundle using at least one feed element. Claim 5 has been amended herein without prejudice to recite the step of pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length. Support for this amendment can be found for instance in the Specification at page 2, lines 17 to 22, which states that "the fiber bundle strand is cut into partial bundles of a suitable length [in contrast to conventional arrangements that] lead to clippings and to fiber losses." Claim 5 recites that the method includes the step of releasing the unbound partial bundles from the at least one feed element. Claim 5 also recites that the method includes the step of gripping the unbound partial bundles using at least one gripping element. Claim 5 further recites that the method includes the step of releasing the unbound partial bundles from the at least one gripping element. In addition, claim 5 recites that the method includes the step of placing the unbound partial bundles having the same lengths in a first collection trough of a collection device. Claim 5 also recites that the method includes the step of rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough of the collection device.

Claim 20 relates to a method for manufacturing a filter element for a dialyzer, the filter element including fiber bundles having a fiber bundle length. Claim 20 recites that the method includes the step of transporting a fiber bundle using at least one feed element. Claim 20 has been amended herein without prejudice to recite the step of pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length. Support for this amendment is set forth above. Claim 20 recites that the method includes the step of releasing the unbound partial bundles from the at least one feed element. Claim 20 also recites that the method includes the step of gripping the unbound partial bundles using at least one gripping element. Claim 20 further recites that the method includes the step of releasing the unbound partial

bundles from the at least one gripping element. In addition, claim 20 recites that the method includes the step of placing the unbound partial bundles having the same lengths in a first collection trough of a collection device. Claim 20 also recites that the method includes the step of rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough of the collection device.

Koehler purports to describe a machine for making tassels. Col. 1, lines 1-2. More specifically, Koehler states that “the machine makes tassels of the type in which short sections of threads or cords ... are folded to form an eye and bound together adjacent to the eye by means of a wire ring or staple.” Col. 1, lines 2-6.

It is respectfully submitted that Koehler fails to disclose, or even suggest, the step of pre-cutting a fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length, as recited in amended claims 5 and 20. In contrast, Koehler describes that threads 51 and 54 are fed through tubes 52 and 55, respectively, where they are clamped, folded, etc. Page 2, lines 42-51. After the threads or cords have been bound together to form the tassel, “the ends [of the threads or cords] are snipped or cut off by adjustable knives 161 and 162 to cut the same to proper length and to make the end of the finished tassel even.” Page 3, lines 108 to 111. Thus, in order that the final length of the threads or cords to be equal to the finished length of the tassels, Koehler describes that the ends of the threads or cords are required to be cut at least a second time. Thus, even assuming arguendo that a tassel could be considered to be a fiber bundle having a length, the threads or cords that make up the tassel are not pre-cut to the length of the finished tassel but rather are cut to the length of the finished tassel after the tassel has been formed.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that

Koehler does not disclose, or even suggest, the step of pre-cutting a fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length, as recited in amended claims 5 and 20.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Koehler does not anticipate claims 5 and 20.

IV. Rejection of Claims 1 and 19 Under 35 U.S.C. §103(a)

Claims 1 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Koehler. It is respectfully submitted that Koehler do not render obvious the present claims as amended herein for the following reasons.

Claim 1 relates to a method for manufacturing a fiber bundle having a fiber bundle length from a required number of unbound partial bundles. Claim 1 recites that the method comprises the steps of transporting a fiber bundle strand

using at least one feed element. Claim 1 has been amended herein without prejudice to recite that the method includes the step of pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length. Support for this amendment is set forth above. Claim 1 also recites that the method includes the steps of releasing the unbound partial bundles from the at least one feed element and gripping the unbound partial bundles using at least one gripping element. In addition, claim 1 recites that the method includes the steps of releasing the unbound partial bundles from the at least one gripping element and placing the unbound partial bundles in a first collection trough of a collection device. Claim 1 also recites that these steps are repeated for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained in the first collection trough.

Claim 19 relates to a method for manufacturing a filter element for a dialyzer, the filter element including a fiber bundle having a fiber bundle length from a required number of unbound partial bundles. Claim 19 recites that the method comprises the steps of transporting a fiber bundle strand using at least one feed element. Claim 19 has been amended herein without prejudice to recite that the method includes the step of pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length. Support for this amendment is set forth above. Claim 19 also recites that the method includes the steps of releasing the unbound partial bundles from the at least one feed element and gripping the unbound partial bundles using at least one gripping element. In addition, claim 19 recites that the method includes the steps of releasing the unbound partial bundles from the at least one gripping element and placing the unbound partial bundles in a first collection trough of a collection device. Claim 19 also recites that these steps are repeated for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained in the first collection trough.

The Office Action states that “Koehler discloses the invention substantially as claimed including a step of repeating steps a) to f) for the required number of unbound partial bundles (page 2, lines 36-39).” Office Action at page 4. The Office Action admits that “Koehler fails to disclose repeating the steps a) to f) until a required thickness of the fiber bundle is obtained.” Office Action at page 4. However, the Office Action maintains that “it would have been an obvious matter of

design choice to one having ordinary skill in the art at the time the invention was made to repeat the steps a) to f) until the required thickness of the fiber bundle is obtained (e.g., a required manufacturing amount of bundles) in order to complete a required amount for each containers or collection boxes.” Office Action at page 4.

It is respectfully submitted that Koehler fails to disclose, or even suggest, the step of pre-cutting a fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length when pre-cut equal to the fiber bundle length, as recited in amended claims 1 and 19. In contrast and as set forth above, Koehler describes that threads 51 and 54 are fed through tubes 52 and 55, respectively, where they are clamped, folded, etc. Page 2, lines 42-51. After the threads or cords have been bound together to form the tassel, “the ends [of the threads or cords] are snipped or cut off by adjustable knives 161 and 162 to cut the same to proper length and to make the end of the finished tassel even.” Page 3, lines 108 to 111. Thus, in order that the final length of the threads or cords be equal to the finished length of the tassels, Koehler describes that the ends of the threads or cords are required to be cut at least a second time. Thus, even assuming arguendo that a tassel could be considered to be a fiber bundle having a length, the threads or cords that make up the tassel are not pre-cut to the length of the finished tassel but rather are cut to the length of the finished tassel after the tassel has been formed.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As more fully set forth above, it is respectfully submitted that Koehler does not disclose, or even suggest, the step of pre-cutting a fiber bundle strand into unbound partial bundles, the unbound partial

bundles having a length when pre-cut equal to the fiber bundle length, as recited in amended claims 1 and 19.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify the reference do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have

indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to combine or modify the references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for combining or modifying the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone or modified, would provide the features and benefits of claims 1 and 19. It is therefore respectfully submitted that claims 1 and 19 are allowable for these reasons.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

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Respectfully submitted,
KENYON & KENYON

By: 

Thomas C. Hughes
Reg. No. 42,674

One Broadway
New York, New York 10004
(212) 425-7200